

09/681,050

MS131754.01/MSFTP282US

REMARKS

Claims 1-11 and 13-30 are currently pending in the subject application and are presently under consideration. Claims 1, 7, 11, 24 and 28-30 have been amended as shown at pp. 2-8 of the Reply. Claim 12 has been cancelled as indicated on p. 4 of the Reply. Applicants' representative notes with appreciation the indication that claims 12 and 25 recite allowable subject matter, and would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Accordingly, the allowable limitations (as identified by the Examiner in the previous Office Action) of these objected to claims have been incorporated into the independent claims. In view of these amendments and the below comments, it is believed all claims are in condition for allowance. It is noted that applicants' representative does not agree with the rejections of the originally filed claims based on the cited art or record, and therefore will pursue such claims in a continuation application.

I. Rejection of Claims 1-22 and 24-26 Under 35 U.S.C. §101

Claims 1-22 and 24-26 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Withdrawal of this rejection is respectfully requested for at least the following reasons. Independent claims 1, 11 and 24 have been amended herein to emphasize that the invention relates in large part to *practical* computer-implemented method(s) and/or system(s) that *produce a useful, concrete and tangible result*.

Because the claimed process applies the Boolean principle [abstract idea] *to produce a useful, concrete, tangible result* ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been *reduced to some practical application rendering it "useful."* *AT&T* at 1357 citing *In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (Emphasis added) (holding that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that

09/681,050

MS131754.01/MSFTP282US

produced the useful, concrete, and tangible result of a smooth waveform display).

In the Office Action dated May 11, 2004, it is contended that "claims 1, 11, and 24 represent mere ideas in the abstract since it does not comprise physical means on a tangible medium to carry out the process. Claims 1, 11, and 24 have been amended herein to emphasize that the invention is directed to *computer-implemented* methods and/or system *employing a computer-based component*. Furthermore, the Office Action contends that claim 1 recites acts that do not produce a useful, concrete, and tangible result. However, contrary to such contentions, the specification provides examples of practical applications along with explanations illustrating usefulness of the invention. The specification discloses that the invention *identifies a sub-population of a group to solicit and soliciting this group to maximize expected increase in profits*, which is a *useful, concrete, and tangible result*. (See pg 3, paragraph [0008]). For example, an advertiser's goal of selling the most items at the highest price is consistent with maximizing the advertiser's expected increase in profits. The model is likely to not recommend soliciting an individual who will never buy or is already interested in buying because it will decrease profits. (See pg 4, paragraph [0011])

In view of the above, it is readily apparent that the claimed invention reduces to a practical application that produces a useful, concrete, tangible result; therefore, pursuant to standard set for by Federal Circuit in *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) - the subject claims recite an invention with patentable utility pursuant to 35 U.S.C. §101. Accordingly, this rejection should be withdrawn.

II. Rejection of Claims 1, 10 and 28 Under 35 U.S.C. §103(a)

Claims 1 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tom (US 5,696,907). This rejection should be withdrawn for the following reasons. Independent claims 1 and 28 have been amended to recite the allowable limitations of claim 12, which were deemed allowable by the Examiner. Claim 10 depends from claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

09/681,050

MS131754.01/MSFTP282US

III. Rejection of Claims 2-4, 6, 8 and 29 Under 35 U.S.C. §103(a)

Claims 2-4, 6, 8 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tom as applied to claim 1 above, and further in view of Kohavi (US 6,182,058). This rejection should be withdrawn for the following reasons. Claims 2-4, 6, 8 and 29 depend from independent claims 1 and 28, which has noted above recite the allowable limitations of claim 12. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 5, 7, 11, 13-24, 26, 27 and 30 Under 35 U.S.C. §103(a)

Claims 5, 7, 11, 13-24, 26 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tom as applied to claim 1 above, and further in view of Kohavi, and Pilipovic (US 6,456,982). This rejection should be withdrawn for the following reasons. Claims 5, 7, 13-24, 26, 27 and 30 respectively depend from independent claims 1, 11, 24 and 28, which have been amended to recite allowable limitations of claim 12. Accordingly, withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 9 Under 35 U.S.C. §103(a)

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tom as applied to claim 1 above, and further in view of Amado (5,701,400). Withdrawal of this rejection is respectfully requested because claim 9 depends from independent claim 1, which has been amended to recite the allowable limitations of claim 12.

09/681,050

MS131754.01/MSFTP282US

Conclusion

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[MSFTP282US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731